



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences**

In re Patent Application of

Jonathan Adams

Atty. Ref.: 1444-2

Serial No. 10/825,184

TC/A.U.: 3711

Filed: April 16, 2004

Examiner: M. Chambers

For: IMPROVED DESIGN FOR LACROSSE STICK AND METHOD OF
USING SAME

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Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF

This is in response to the Examiner's Answer dated July 16, 2007.

Applicant will not repeat herein the arguments set forth in the Appeal Brief filed April 12, 2007 (which is incorporated herein by reference), but instead will briefly respond below to certain assertions set forth in the Examiner's Answer in order to complete the record for appeal.

1. Claims 10 and 11

These claims are method claims that affirmatively recite the limitation of "non-destructively adjusting" the length of the shaft of the lacrosse stick during a lacrosse

game without leaving the playing field. Contrary to the argument of the Examiner, one of ordinary skill in the art would well know what the quoted phrase means.

Specifically, he/she would know from a review of the application and experience that the phrase “non-destructively adjusting” means that the shaft of the lacrosse stick can be adjusted without adding or subtracting a part of the shaft. Dill does not meet this definition because the length of the shaft is changed by adding a section or by removing a section. In other words, pieces of the Dill shaft are either added or removed. The Examiner’s Answer admits this at page 4 by conceding that Dill discloses the “insertion and removal of item 604.” This action is contrary to the “non-destructively adjusting” teaching of the Applicants and the above-quoted language in claims 10 and 11.

Furthermore, the Examiner’s alternative argument that one can adjust the length of a lacrosse stick shaft by cutting it to a shorter length is in error for the same reasons – i.e., it is clearly destructive. Cutting a stick results in a permanent loss of a portion of the length of the shaft. Again, this is contrary to the teaching of Applicants’ invention and contrary to the language of claims 10 and 11.

The methods of claims 10 and 11 would not have been obvious in view of Dill due to, inter alia, the claim language “non-destructively adjusting.” The methods of these claims also would not have been obvious for the reasons set forth below with respect to claim 1.

2. Claim 1

Claim 1 is a method claim which recites that a player who is “playing lacrosse” is “capable of intentionally adjusting the length of their lacrosse stick during a lacrosse game without leaving the playing field.” Thus, contrary to the Examiner’s argument at page 4, claim 1 does not merely call for “the capability of intentionally adjusting the length of the lacrosse stick.

For example, Dill does not teach or suggest that his stick can be adjusted on the playing field while playing lacrosse. As noted above, a person of ordinary skill in the art would know that it is not practical or possible to “cut” the length of one’s lacrosse stick on the playing field while playing lacrosse.

Furthermore, anyone skilled in the art would recognize that the Dill device, which teaches that a player is to insert or remove a portion of a lacrosse shaft, is not adjusted during a game on the playing field. For example, if one were playing lacrosse and (while doing so) took out a portion of the stick, the player would not be able to play with stick because one of his/her hands would be holding the removed portion. Likewise, if a player wanted the option to insert a section, he/she would have to play the game holding that extra section until it was inserted. Again, this is something that one of ordinary skill in the art would readily recognize as being undesirable and impractical. Instead, such a person would recognize that the Dill adjustment takes place off of the playing field.

Finally, the Examiner’s arguments with respect to claim 1 appear to be based upon the assertion that “any stick is capable of being adjusted on the playing field” (emphasis in original) in view of the Applicants’ admission that players can cut their sticks to make

them shorter. However, simply stated, anyone skilled in the art knows that players do not cut their sticks on the playing field during a game.

For example, it takes very strong cutting tools to cut a metal lacrosse stick shaft. It simply is not possible (e.g., it would be dangerous) for players to take such cutting tools onto a playing field during a game. Can one realistically imagine lacrosse players playing a lacrosse game while carrying around a hack saw or other cutting tool?

The method of claim 1 would not have been obvious in view of Dill because it does not teach or suggest adjusting the length of a lacrosse stick “during a lacrosse game without leaving the playing field” while the person is “playing lacrosse.”

3. Claim 2

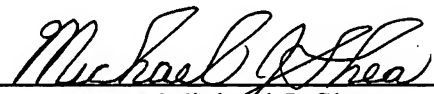
Similar to the argument with respect to claim 1, claim 2 is a method claim which recites that the lacrosse players adjust the length of their sticks while “playing lacrosse.” Thus, the method of claim 2 would not have been obvious in view of Dill. As noted above, lacrosse players would not want to have their hands full of extra pieces of their sticks. That is not a realistic way to play lacrosse.

4. Conclusion

It is respectfully requested that all rejections be reversed.

Respectfully submitted,

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